

Application Serial No. 10/580,510
Attorney Docket No. 10191/4232
Reply to Office Action of February 12, 2009

AMENDMENTS TO THE DRAWINGS:

Please replace Figures 1 and 2 with the accompanying Replacement Sheets for Figures 1 and 2. The Figures have been corrected as to certain minor formalities, as suggested. No new matter is introduced. Approval and entry are respectfully requested.

Attachments: Two Replacement Sheets.

REMARKS

Claims 16 to 19 are added, and therefore claims 8 to 19 are pending.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

As to the version 1.04 of the IEEE reference, the International Search report satisfies any requirement to describe the prior art as to this reference. On October 29, 2008, the Office acknowledged having considered IEEE 1394 Version 1.05. *See* IDS of May 23, 2006 (only document in the "other documents" section, listed with alternative title). Version 1.04 is understood to be cumulative as to version 1.05. Still further, the specification and Fig. 2 also concern and detail the relevant portions of the IEEE specification, as noted in the objection to the drawings. For at least these reasons, Applicants respectfully request that the objection be withdrawn.

The drawings were objected to as to certain formalities. Replacement drawings have been included with this response. Approval and entry are respectfully requested, as is withdrawal of the objections.

The specification was objected to, and has been rewritten as suggested. Applicants respectfully request that the objection be withdrawn.

Claim 11 was rejected under 35 U.S.C. § 112, first paragraph, as to the enablement requirement.

The Office asserts that IEEE 1394.1 was not approved until July of 2005, whereas the present PCT application was filed in November of 2004. However, the claim does not reference the "approved" version of the 1394.1 standard. The standard has been publicly available since July of 1996. A person of ordinary skill in the art would routinely use proposed IEEE standards while awaiting a finally approved version. Thus, even if experimentation were required for implementing an embodiment of claim 11 (based on any version of the 1394.1 standard), it would not be undue experimentation.

It is therefore respectfully requested that the enablement rejection be withdrawn as to claim 11 for this reason alone.

As further regards the enablement rejection as to claim 11, it is respectfully submitted that the Office Action's assertions and arguments presented do not reflect the standard for determining whether a patent application complies with the enablement requirement that the specification describe how to make and use the invention -- which is defined by the claims. (See M.P.E.P. § 2164). The Supreme Court established the

appropriate standard as whether any experimentation for practicing the invention was undue or unreasonable. (See M.P.E.P. § 2164.01 (citing Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916); In re Wands, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed Cir. 1988))). Thus, it is axiomatic that the enablement test is “whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” (See id. (citing United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988))).

The Federal Circuit has made clear that there are many factors to be considered in determining whether a specification satisfies the enablement requirement, and that these factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. (See id. (citing In re Wands, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407)). In this regard, the Federal Circuit has also stated that it is “improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors,” and that the examiner's analysis must therefore “consider all the evidence related to each of these factors” so that any nonenablement conclusion “must be based on the evidence as a whole.” (See M.P.E.P. § 2164.01).

Also, an examiner bears the initial burden of establishing why the “scope of protection provided by a claim is not adequately enabled by the disclosure.” (See id. (citing In re Wright, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993))). Accordingly, a specification that teaches the manner and process of making and using an invention in terms that correspond in scope to those used in describing and defining the claimed subject matter complies with the enablement requirement. (See id.).

In contrast to the above, however, it is respectfully submitted that the Office Action's unsupported assertions simply do not concern — as they must under the law — whether the present application enables a person having ordinary skill in the art to practice the claimed subject matter of the claims without undue experimentation — which it plainly does, as would be understood by a person having ordinary skill in the art in view of the disclosure of the present application, including the specification. In short, the Office Action's assertions are merely conclusory and do not address the issue of whether one having ordinary skill would have to unduly experiment to practice the claimed subject

matter of the rejected claims — *a proposition for which the Office bears the burden of proving a prima facie case as to the rejected claims.*

In this regard, to properly establish enablement or non-enablement, the Office must make use of proper evidence, sound scientific reasoning and the established law. In the case of Ex Parte Reese, 40 U.S.P.Q.2d 1221 (Bd. Pat. App. & Int. 1996), a patent examiner rejected (under the first paragraph of section 112) application claims because they were based on an assertedly non-enabling disclosure, and was promptly reversed because the rejection was based only on the examiner's subjective belief that the specification was not enabling as to the claims. In particular, the examiner's subjective belief was simply not supported by any “evidence or sound scientific reasoning” and therefore ignored recent case law — which makes plain that an examiner (and not an applicant) bears the burden of persuasion on an enablement rejection.

More particularly, the examiner in Ex parte Reese was reversed because the rejection had only been based on a conclusory statement that the specification did not contain a sufficiently explicit disclosure to enable a person to practice the claimed invention without exercising undue experimentation — which the Board found to be merely a conclusory statement that only reflected the subjective and unsupported beliefs of a particular examiner and that was not supported by any proper evidence, facts or scientific reasoning. (See id.). Moreover, the Board made clear that it is “incumbent upon the Patent Office . . . to back up assertions of its own with acceptable evidence,” and also made clear that “[where an] examiner's 'Response to Argument' is not supported by evidence, facts or sound scientific reasoning, [then an] examiner has not established a *prima facie* case of lack of enablement under 35 U.S.C. § 112, first paragraph.” (See id. at 1222 & 1223; italics in original).

In the present case, the Office Action has not even alleged – let alone established -- in a conclusory way that undue experimentation would be required. Moreover, even as to the assertions as presented, the present application plainly discloses how to use the subject matter of the rejected claims, as explained above.

It is therefore respectfully requested that the enablement rejection be withdrawn as to claim 11.

Claims 8 to 15 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

While this rejection may not be agreed with, claim 8 has been rewritten to replace the objected-to term “useful.” Support may be found at page 4, line 3 of the Substitute Specification. It is therefore respectfully requested that the indefiniteness rejection be withdrawn as to claim 8.

Claims 8 to 14 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application No. 2003/0053466 (“Bizet”).

As regards the anticipation rejections of the claim, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejection, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

Claim 8, as presented, is to a network bridge, including “at least one interface for providing access to at least some functional blocks of the network bridge for polling and evaluation of at least one of statistical data, performance data, operating data, and parameters, and for manipulation of the at least one of statistical data, performance_data, operating data, and parameters, and of the functional blocks, as a function of the evaluation, *including detecting a defect in or an attack from a device connected to the network bridge.*” The Bizet does not identically disclose (or even suggest) this claim feature.

In the rejection of claim 14, which contains features like those of claim 8, paragraph 190 of Bizet is cited for stating that the network description “list can be updated

when a change (the addition or elimination of a bridge) appears.” However, updating the network map when a node is connected or disconnected does not identically disclose (or even suggest) the above quoted feature. The Bizet reference concerns a system for connecting multiple 1394 buses together via a Network. The Bizet reference thus relates to clock delay methods to facilitate the connection of multiple 1394 buses. Therefore, the detecting of a connecting of a node to the network described in Bizet could not possibly be characterized as “detecting a *defect*” in the Bizet system. Disconnecting could not be characterized as “detecting a defect” in the Bizet system for the same reason. However, additionally, disconnecting does not disclose the above-discussed feature, as it provides for “detecting a defect in or an attack from *a device connected to the network bridge*.” Likewise, a connected or disconnected node does not constitute “an attack.”

For at least these reasons, claim 8 is allowable, as are its dependent claims 9 to 14.

Additionally, claim 14 should be allowed for the further reason that Bizet does not disclose the feature of “an allocation of memory regions . . . is a function of a statistical evaluation of a data volume *for different data types* including at least one of *asynchronous* and *isochronous* data.” At best, Bizet may only concern this in relation to facilitating a desired delay pattern in *isochronous* data. In fact, paragraph 0259 of Bizet states that “[t]he transfer of asynchronous packets does not form part of the present invention.” The Bizet reference only concerns one type of data, isochronous, and therefore does not disclose “a data volume *for different data types*”, as provided for in the context of the claimed subject matter.

Claim 15 was rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Bizet.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to

combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

The Office Action conclusorily asserts that “[i]n order to instantiate the FIFO memories of a homogeneous network bridge from a remote location, the network bridge would have had a network layer established such that the controller C would be given access to the internal workings of the network bridge.” Further, the Office Action asserts that “[i]t would have been obvious . . . to implement a network layer . . . such that a network controller could remotely instantiate FIFO memories in the event that the network bridge does not accurately instantiate FIFO memories for the streaming connections.” (Office action at page 9).

There is, however, no indication in Bizet that remote, network-based instantiation of local memory queues would even be compatible with its systems. No reference for this functionality was provided, and it is not even clear how a node configured to transfer data to/from multiple other nodes, could have a local and dynamic process, such as FIFO memory instantiation, performed remotely. It is respectfully submitted that there is simply no reason to combine Bizet with remote instantiation of memory queues.

Any relied upon Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by that Official Notice under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the rejection is apparently based on assertions that draw on facts within the personal knowledge of the Examiner. (See also MPEP § 2144.03).

For at least these reasons, claim 15 is allowable. Additionally, claim 15 depends from claim 8, and is allowable for essentially the same reasons.

New claims 16 to 19 do not add any new matter, and are supported by the present application, including the specification. These claims depend from claim 8, as presented, and are therefore allowable for at least the same reasons.

Accordingly, claims 8 to 19 are allowable.

CONCLUSION

In view of the above, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn, since they have been obviated. Since all issues raised have been addressed, an early and favorable action on the merits is respectfully requested.

Dated: _____

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Respectfully Submitted,

By: _____

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